

REMARKS

Claims 1-13, 15-30 and 32-40 are pending in this application. By this Amendment, claims 14 and 31 are cancelled without prejudice or disclaimer, claims 1, 7, 9, 10, 23, 24, 27, 29 and 32 are amended and new claims 37-40 are added.

The Office Action rejects claims 7, 9, 14, 24 and 31 under 35 U.S.C. §112, second paragraph. It is respectfully submitted that the above amendments obviate the grounds for rejection. More specifically, claims 7 and 24 are amended to depend from claims 6 and 23, respectively. Claims 6 and 23 provide the proper antecedent basis for the respective terms set forth in claims 7 and 24. Additionally, the Office Action states it is unclear whether "said service information" in claim 9 refers to the "service information concerning the user" in claim 1, line 3 or the "service information for the user to be used by the user terminal" in claim 1, line 8. It is intended that the service information recited in claim 9 refers to the same service information saved in the registrar and sent to the user. As such, claim 9 recites that the push proxy automatically stores the service information in the registrar when the user terminal subscribes to the communication services. Still further, claims 14 and 31 have been cancelled and similar features have been recited in independent claims 10 and 17. The features recited in claims 10 and 27 recite that the proxy server resubscribes the user to ongoing subscriptions for which service information is stored. Thus, there is no lack of antecedent basis. Withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

Applicant gratefully acknowledges the Office Action's indication that claims 20, 22 and 36 are allowable over the prior art of record.

The Office Action rejects claims 1-7 and 32-35 under 35 U.S.C. §102(b) by U.S. Patent 5,313,653 to Sasuta. The Office Action also rejects claims 1, 8, 9, 18, 19, 21 and 23-31 under 35 U.S.C. §102(a) by Rosenberg ("SIP and Instant Messaging"). Still further, the Office Action rejects claims 10-17 under 35 U.S.C. §102(a) by Donovan ("IMPS - Instant Messaging and Presence Using SIP"). The rejections are respectfully traversed.

Independent claim 1 recites that the header in a subscription message contains a unique indication of a particular user. Similarly, independent claim 32 recites a header in a subscription message containing a unique identification of a particular user. For example, the unique indication (or unique identification) of a particular user may be a user identification or an event name. The applied references do not teach or suggest these features of independent claims 1 and 32.

More specifically, the Office Action (when discussing Sasuta and Rosenberg) states that a header in the subscription message inherently contains a unique indication identifying the user terminal. However, a header in a subscription message does not inherently contain a unique indication of a particular user. For example, a terminal identification is not a unique indication identifying the user terminal. There is no certainty (or even any suggestion) that a header contains a unique indication of a particular user. As stated by the Federal Circuit, inherency may not be established by probabilities or possibilities. The mere fact that a certain

thing may result from a given set of circumstances is not sufficient. See Continental Can Company et al. v. Monsanto Company et al., 20 U.S.P.Q. 2d 1746, _____ (Fed. Cir. 1991). Clearly, a header does not always (or inherently) contain a unique indication of a particular user or a unique identification of a particular user. Rosenberg and Sasuta also do not suggest that a header contains a unique indication of a particular user. As such, independent claims 1 and 32 define patentable subject matter.

Independent claim 10 further recites that when the proxy server receives the request from the user terminal, the proxy server resubscribes the user to ongoing subscriptions for which service information is stored therein. Similar features were previously recited in dependent claim 14. In rejecting dependent claim 14, the Office Action states that Donovan anticipates a scenario where a user may re-subscribe to the subscription when the proxy server receives the request from a user terminal. However, Donovan does not disclose any re-subscription to a subscription when the proxy server receives the request as alleged. As such, Donovan does not teach or suggest all the features of independent claim 10. Independent claim 10 therefore defines patentable subject matter. Should the Patent Office maintain this rejection based on Donovan, the Patent Office is requested to specifically point to a location within the Donovan reference as showing these features.

Independent claim 27 recites that when the proxy server receives the request from one of the user terminals, the proxy server resubscribes the user to ongoing subscriptions for which service information is stored therein. Independent claim 27

therefore defines patentable subject matter for at least similar reasons as independent claim 10.

Each of claims 2-9, 18-26, 37 and 38 depend from claim 1 and therefore also define patentable subject matter. Each of claims 33-36, 39 and 40 depend from claim 32 and therefore also define patentable subject matter. Still further, each of claims 11-17 depend from claim 10, and each of claims 28-30 depend from claim 27 and therefore also define patentable subject matter at least for this reason. In addition, the dependent claims also recite features that further and independently distinguish over the applied references. For example, dependent claim 37 recites that the unique indication comprises an event name particular to a specific user. Dependent claim 38 recites that the unique indication comprises identification of the particular user. Dependent claims 39 and 40 recite similar features relating to the unique identification. The applied references do not teach or suggest these features. Further, these features are not inherently within the known prior art. As such, these claims 37-40 define patentable subject matter for at least this additional reason.

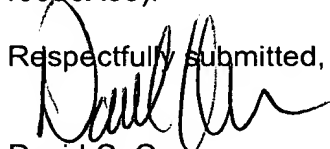
For at least the reason set forth above, it is respectfully submitted that each of claims 1-13, 15-30 and 32-40 define patentable subject matter. Withdrawal of the outstanding rejections are respectfully requested.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-13, 15-30 and 32-40 are respectfully requested.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (referencing case no. 0172.40096X00).

Respectfully submitted,



David C. Oren
Registration No. 38,694
ANTONELLI, TERRY, STOUT & KRAUS, LLP

DCO/pay
(703) 312-6600